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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,619	08/01/2001	Christian Criegee	P 281519 / 000319 OC	2502
909	7590	03/14/2005	EXAMINER	
PILLSBURY WINTHROP, LLP			GRAY, JILL M	
P.O. BOX 10500				
MCLEAN, VA 22102			ART UNIT	PAPER NUMBER
			1774	
DATE MAILED: 03/14/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

4D

<b>Office Action Summary</b>	<b>Application No.</b> 09/919,619	<b>Applicant(s)</b> CRIGEE ET AL.	
	<b>Examiner</b> Jill M. Gray	<b>Art Unit</b> 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 6-9, 11 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-9, 11, 13-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Response to Amendment***

The objection to claim 11 is withdrawn in view of applicants' amendment.

The rejection of claims 2, 4, and 8 under 35 U.S.C. 112, second paragraph is moot in view of applicants' amendment.

The cancellation of claim 4 has been noted.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6, 9, 11, 13, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheibli et al, 6,036,731 (Scheibli) taken alone or in view of Boyer 4,104,250, for reasons of record.

Claims 7, 8, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheibli et al, 6,036,731 (Scheibli) taken alone or in view of Boyer 4,104,250, each as applied above to claims 1-3, 6, 9, 11, 13, and 16-19, and each further in view of Buehler et al, 3,776,767 (Buehler) for reasons of record.

### ***Response to Arguments***

Applicant's arguments filed December 22, 2004 have been fully considered but they are not persuasive.

Applicants argue that Scheibli does not teach that the 4-6dichlorotriazinyl amine compound may be used in an amount between 20 to 80%, but rather teaches that the compound should be used in amounts lower than Applicants' recited range, further arguing that Scheibli teaches that the disclosed compounds should only be used in amounts from 0.01 to 20% by weight relative to the cellulose fiber, which is confirmed by examples 1, 2, and 5 of Scheibli. Accordingly, applicants argue that Scheibli does not anticipate nor render obvious applicants' claimed invention.

Agreeably Scheibli teaches that his compound could be used in amounts from 0.01 to 20% by weight relative to the cellulose fiber. It is the examiner's position that a *prima facie* case of obviousness exists where the claimed range and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. MPEP 2144.05. Therefore, it is the examiner's position that compounds present in an amount of 20% by weight is close enough to the lower end of the claimed range of between 20% and 80% that one skilled in the art would have expected the resultant cellulose articles to have the same properties. Accordingly, a *prima facie* case of obviousness exists. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir.1985).

Applicants argue that the secondary references fail to remedy the deficiencies of Scheibli, further arguing that neither Boyer nor Buehler teach or suggest that the amount of compound used by Scheibli could be modified to fall within the range claimed by applicants. Applicants additionally argue that a skilled artisan would have no motivation to adjust the range specified by Scheibli and arrive at applicants' claimed

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invention and that if modified, there would be no expectation that applicants' claimed invention could be successfully produced, in particular, there would be no expectation that the disclosed compound of Scheibli could be used in the amounts recited in applicants' claims to impart the desired flameproof properties and the teachings of Scheibli, Boyer, and Buehler by themselves or in combination, simply do not provide a skilled artisan with the requisite motivation to alter the disclosures in a manner that would allow the skilled artisan to arrive at applicants' claimed invention.

In this regard, Boyer and Buehler are each relied upon for all that they would have reasonably imparted to one of ordinary skill in the art at the time the invention was made. In particular, Boyer clearly teaches that compounds of the type contemplated by applicants and taught by Scheibli are known in the art to impart a high degree of flame retardant properties; and, Buehler teaches that it is known in the art to use compounds of the type contemplated by applicants and as taught by Boyer in combination with phosphorus compounds in finishes for cellulosic materials. As to applicants' argument that "the skilled artisan would have no motivation to adjust the range specified by Scheibli and arrive at the present claimed invention" and "if modified, there would be no expectation that the present invention could be successfully produced" or that "the compound of Scheibli could be used in amounts recited in applicants' claims to impart the desired flameproof properties", the examiner's position remains that a *prima facie* case of obviousness exists for reasons previously stated. As set forth previously, applicants have provided no evidence on this record that there is no reasonable expectation of similar properties in the similar compounds of the claims and Scheibli,

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nor is there evidence clearly establishing a substantial degree of unpredictability in this art area as it relates to the compounds of the claims and prior art Scheibli, and, there is no evidence on this record that the claimed compounds of present claims 1 and 9 possess unexpected advantageous or superior properties.

No claims are allowed.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-F 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jill M. Gray  
Examiner  
Art Unit 1774

jmg



RENA DYE  
SUPERVISORY PATENT EXAMINER

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